REMARKS

Claims 1 through 23 are pending in this application. Claim 1 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

I. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1 through 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sukurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630).

Respectfully, according to MPEP 706.02(j), the examiner did not establish a *prima facie* case of obviousness under 35 U.S.C. §103.

A. The Examiner has failed to show that the references teach or suggest all of the claim limitations.

1. As seen for example in claim 4, the combination of references fails to teach or suggest *said indicator being initially displayed at a predetermined position within said menu*. Nowhere in the Examiner's arguments does he indicate that the combination of references teaches or suggest such claim elements. Sakurai concerns the hierarchical menu systems but does not teach or suggest the indicator being initially displayed at a predetermined position within the menu. All Miyatshita shows is a remote with pointing device that controls the pointer as mentioned by the Examiner on col. 5, lines 1-5 of Miyatshita. The combination does not teach or suggest a set position of the indicator and a set position being within the menu. Respectfully, the Examiner is assuming the references show a set initial position of the cursor or indicator from vague facts that do not

clearly disclose such a limitation.

2. As seen for example in claim 4, the combination of references fail to teach or suggest *storing a location of said menu item in reference to said menu area.* In claim 17 of Sukurai '685 , it states "a memory storing said menu display definition files each corresponding to one of said menu displays, each of said menu display definition files comprising definitions of items displayed on said corresponding one of said menu displays and definitions of said processes each carried out upon selection of a corresponding one of said items. In col. 10, lines 11-16 of Sukurai '685, it states "If a selection is made for return to a previous display at this point, a menu display corresponding to the file name #1.TBL stored in the area 2 is displayed. Since the current hierarchy level has returned to the second level, an area which stores a file name at the time of displaying a next submenu is the area 3, again" In col. 9, lines 44-46 of Sukurai '685 states "At the same time, the file name of the submenu is stored in a display-file-name storage area allocated in a memory." Throughout Sukaurai '685 one can see that there is no mention of storing the menu item location according to the menu area as seen in the present invention but more with file names as mentioned above, "file name of the submenu is stored." Sukaurai is dealing more with menu hierarchy as using file definitions and menu file names and not actual menu area. Miyashita fails to mention anything further, and therefore, the combination fails to teach or suggest the claimed element.

3. As seen for example in claim 8, the combination of references do not teach

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or suggest *automatically adjusting display of said indicator to display said indicator on said screen at said location of said menu item*. The <u>only</u> mention of the indicator in Sukaurai '685 is in col. 9, lines 48-57 and in col. 10, lines 4-5, which mentions "An area indicator is incremented by one each time a new submenu is displayed, i.e., each time the display proceeds to a next menu. On the other hand, the area indicator is decremented by one each time a previous menu is displayed, i.e., each time the display returns to a previous menu. In this manner, the history of menu selections as to a movement in a depth direction of the hierarchy can be stored in the display-file-name storage area...At the same time, the area indicator is decremented by one." Clearly Sukarai '685 does not teach or suggest adjusting the indicator to a location with respect to the <u>display screen</u> and menu item. The display screen is not involved in the positioning of the indicator in Sukarai '685. Sukarai '685 is dealing only with the <u>internal workings of the menu</u> and <u>not the display</u>. The relation with the display is necessary because it is quite helpful to the user. The combination of references, however, are in regards to the internal index of the menu and submenus themselves with incrementing of one or decrementing of one to show the depth of menu system only (i.e., whether it is at a menu level or submenu level hierarchy) which is more helpful to the internal workings of a menu system rather than helping with the interfacing with a user .

As further evidence of the above, as seen above in col. 9, lines 56-57 of Sukarai '685, Sukarai '685 only deals with "movement in a depth direction of the heirarchy". Clearly this does not teach or suggest a location of the <u>displayed indicator</u> within the <u>displayed menu item on the screen</u> but only a <u>depth direction</u> of the menu system of whether it is in a submenu or menu.

Again Miyashita fails to mention anything further. Miyashita makes no teaching or suggestion on how to control the cursor or indicator when dealing with a menu system. Therefore, the combination fails to teach or suggest the claimed element.

4. As seen for example in claim 17 of the present invention, *a shift value data storage unit accommodating the storing shift value data* is not taught or suggested by the combination of references. Neither Miyashita, nor Sakurai mentions a shift value storage unit. The elements mentioned by the examiner do not teach or suggest such an element. The present invention is shown to use the shift values to move the cursor or indicator, but Miyashita or Sakurai does not teach or suggest this.

5. Concerning the rejection of claims 1 through 23 as being unpatentable over Sukurai in view of Miyashita, the Examiner asserts that the area indicator disclosed in column 9, lines 46-56, and Fig. 13A in Sukurai is similar to the indicator of the present invention. However, the Applicant believes that the rejection is improper since the area indicator of Sakurai is for indicating a history and current status of submenus, and is not specifically for selecting an item of a menu.

As mentioned earlier, the area indicator is only mentioned in col. 9, lines 46-56 and col. 10, lines 4-5 and figure 13A. In col. 9, lines 46-56 and in col. 10, lines 4-5, the area indicator is incremented by one each time depending on whether a new submenu is displayed or decremented · when the previous menu is displayed. Clearly this does not teach or suggest that the indicator of Sukurai is used for selection of the menu items, but instead indicates a history and current status of the submenus.

Further, in Sukurai, the area indicator is <u>not shown to a user</u>, but is merely a pointer having . a value automatically increased or decreased by a management program as clearly mentioned in col. 9, lines 46-56 of Sukurai. Further, as seen in col. 5, lines 22-23 of Sukurai, it mentions that figures 13A to 13D concerns the "<u>display-file-name storage area for storing a menu history.</u>" The area

indicator mentioned is not being displayed to a user but being used to show the storage area. Clearly, the area indicator of Sukurai is only an internal pointer that only concerns the internal workings of Sukurai. On the other hand as seen in claim 1 for example of the present invention, the "indicator" itself is "displayed." Therefore, it would be clearly improper to use the area indicator of Sukurai against the present invention because the area indicator of Sakurai is quite different from the indicator of the present invention.

Miyashita may disclose an apparatus to control the position of a cursor but does not disclose how to control the initial position of the indicator when a menu is generated or after the menu has disappeared.

Therefore, the cited references and the combination of the cited references do not teach or suggest all the claim limitations.

B. Sukurai is not analogous to the present invention.

Respectfully, Sukurai is not analogous to the presently claimed invention. According to MPEP §2141.01(a):

> The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have

commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Sukurai is dealing with the hierarchical menu system while the present invention is dealing with making it easier to manipulate a cursor or indicator in a television screen as seen in claim 8. Sukurai does not have the problem of having to manipulate the indicator as seen figure 13A because the indicator is locked permanently to the menu and there is no indication that the indicator can move in any direction away from the menu while the presently claimed invention as mentioned in claim 8. The present invention can do much more than the invention in Sukarai because the present invention is dealing with images and menus in the television (claim 8 for example) while Sukarai deals with only the menu only and therefore, with the lack of mobility of the cursor, it does not face the same problems that the present invention is trying to correct.

Furthermore, Sakurai is not dealing with a television as seen in claims 8 and 17 for example.

Later, in MPEP §2141.01(a), there is a discussion about the *In re Oetiker* case:

Applicant claimed an improvement in a <u>hose clamp</u> which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was <u>not within the field of applicant's endeavor, and was not reasonably pertinent to the</u> <u>particular problem with which the inventor was concerned because it had not been</u>

shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

(underlining added for emphasis)

Respectfully, therefore, according to MPEP §2141.01(a) and cases such as *In re Oetiker* cited above, the reference of Sakurai is not within the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventor was concerned because it has to be shown that person of ordinary skill, seeking to solve a problems of a mobile cursor of the present invention would reasonably be expected or motivated to look to menu systems that have restricted indicators that do not have the same problems and the same benefits. The restricted indicators are always linked to the menu systems and cannot function in any other way. Furthermore as mentioned earlier the restrictive area indicator of Sakurai is only dealing with internal workings and not even displayed to a user as seen in the present invention.

C. Sukurai teaches away from the claimed combination.

Sukarai '685 teaches away from the present invention because as shown above, Sukarai '685 deals with adjusting the indicator according to file names. There is no mention of a location with respect to the display screen or a menu area. The display screen is not involved in the positioning of the indicator in Sakurai whereas the presently claimed invention does. Sukarai '685 is dealing only with the menu itself and not the display. The references are in regards to an index of the menu

and submenus themselves with incrementing of one or decrementing of one. This is teaching away from moving the indicator with respect to display and the menu. As mentioned above, the indicator shown in Sukurai is not even used for selection but just an internal pointer that is incremented or decremented to keep track of the menu level. As seen above in Sukarai '685, Sukarai '685 has an indicator that only deals with "movement in a depth direction of the hierarchy" (col. 9, lines 56-57). Keeping track of only a menu level is obviously a limited scope and different than the present invention. This is teaching away from a location within the display screen or menu area by only teaching a depth direction of the menu system of whether it is in a submenu or menu. This further teaches away from a cursor or indicator to be freely moved anywhere on the display for selection of items.

Furthermore, the area indicator of Sukarai is only an internal pointer for use in the internal workings of the Sukari's patent (as seen in col. 5, lines 22-23 of Sukurai, it mentions that figure 13A concerns the "display-file-name storage area for storing a menu history") and is not even displayed to a user. Clearly, Sukarai is teaching away from the claimed invention.

D. The motivation given by the Examiner to combine or modify the combination is improper

The examiner states that one would have been motivated in view of the suggestion in Miyashita that the desired manually operated remote controller is equivalent to Miyashita's remote controller, and the use of which helps for wirelessly transmitting an operation signal as taught by Miyashita. Respectfully, the logic is circular and conclusory.
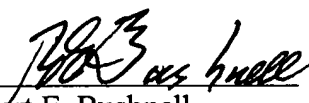
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Respectfully, the motivation mentioned by the examiner is then clearly showing improper hindsight reconstruction. As mentioned strongly in the recent United States Court of Appeals for the Federal Circuit decision in *In Re Sang Su Lee*, docket number 00-1158 (serial number 07/631,240), decided January 18, 2002, the court stated that the "particular findings must be made as to the reason the skilled artisan, with <u>no knowledge of the claimed invention, would have selected these components for combination in the manner claimed</u>. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The court further stated, that the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). The fact that the examiner is looking to the present invention to see if the remote control is equivalent to the remote control in Miyashita in order to show the motivation to combine with Sakurai is then improper according to the *Dembiczak* court, using the present invention as a "<u>blueprint</u> for piecing together the prior art to defeat patentability" and the *In Re Sang Su Lee* and *In re Kotzab* courts, by improperly using knowledge of the claimed invention to select components for combination in the manner claimed.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

The Applicant would also like to note that the PTO-1449 form from the IDS filed on 1 April 2002 still has not been returned acknowledging the consideration of the enclosed five (5) documents in the IDS.

No fee is incurred by this Amendment. However, should there be a fee or other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend claim 1, as follows:

1   1.   (Amended) A method, comprising the steps of:

2   displaying a menu and an indicator [on a display screen by manually operating a remote

3   controller, with said indicator being initially displayed at a predetermined position within] for

4   selecting one of menu items of said menu;

5   making a selection of a menu item [displayed within said display screen by moving] by using .

6   said indicator [around said menu to said menu item];

7   [storing a location of said menu item within said display screen;]

8   displaying a sub menu [of said] corresponding to the selected menu item, with said sub menu

9   being comprised of a plurality of sub menu items contextually related to said menu item [, with said

10   indicator being displayed on said display screen within an area of said sub menu where said sub

11   menu items are displayed, and erasing said sub menu]; and

12   automatically adjusting [display] the position of said indicator to [display said indicator on

13   said screen at said location of said menu item] be located within said sub menu.